DETAILED ACTION

Miscellaneous

1. The examiner notes that there are two issues with Applicant's amendment. First and foremost, the examiner notes that there are no currently pending claims in that the applicant has shifted the invention. Claims **1-28, 31-37** are directed to an invention that is independent or distinct from the invention originally claimed for the reasons noted below. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims **1-28** and **31-37**, are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Secondly, the specification is objected to and will not be entered for the reasons noted below.

Applicant should feel free to contact the examiner if Applicant feels that it would help resolve the outstanding issues.

Specification

2. The amendment to the specification, filed 6/29/2009, is hereby objected to and will not be entered.

Section (c) of The Incorporation by Reference section of MPEP 608.01(p) states that "essential material" may be incorporated by reference. "Essential material" is material that is necessary to provide a written description of the claimed invention, and of the manner and

process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112.

In this case, the subject matter of the amendment to the specification does appear to be material to the claimed invention; however, the amendment to the specification does not provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. That is, neither the instant application, nor the application incorporated by reference teaches the entirety of the claimed invention in full, clear, concise, and exact terms so as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. The instant application is directed towards collecting subscriber content-choice data from a plurality of cable system operators and storing the data in a clearinghouse. The subscriber content-choice data is indicative of the content viewed by subscribers. Application 09/496,825 is directed towards tracking subscriber interaction with content (channel changes, etc.) and analyzing this interaction. Neither application discloses the entirety of the invention as currently recited in the claims, as required by the written description requirement of USC 112, first paragraph.

Applicant argues that paragraph [0039] of the instant application explains how one would make and use the claimed invention. Applicant argues that paragraphs [0018] and [0019] of Application 10/017,742, which is incorporated by reference, explains how "clickstream data" is

used to determine a subscriber's content-choice information. The examiner notes that section (c) of the Incorporation by Reference section of MPEP 608.01(p) requires that the incorporated subject matter be from a published US patent application. Application 10/017,742 does not appear to be published. An amendment to the specification to include subject matter from application 10/017,742 would further not be entered for the reasons discussed above with regard to application 09/465,825.

Response to Amendment

3. The reply filed on 6/29/2009 is not fully responsive to the prior Office Action, because of the following omission(s) or matter(s):

There are no currently pending claims in that the applicant has shifted the invention.

Claims **1-28**, **31-37** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the instant amendment has removed the sub-combination with limitations directed towards collecting subscriber content-choice data from a plurality of service providers and storing it in a clearinghouse database and amended the claim with a sub-combination directed towards receiving clickstream data from subscribers, merging the clickstream data to generate subscriber content choice data, and storing the subscriber content-choice data in a database. Since these sub-combinations have separate utility, such as transmitting subscriber information from a plurality of service providers to a clearinghouse for presentation to requesters, which is not required in transmitting subscriber information from a plurality of subscribers to a service provider for transmission to requesters, the restriction is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims **1-28** and **31-37**, are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424